

REMARKS/ARGUMENTS

1. The Examiner rejected claims 157-191 as being anticipated by Duncan alone or in combination with various references.

Claims 157-191 have been canceled and replaced with new claims 192-222. For reasons discussed below, the subject matter of original claims 158, 164, 175, and 176 has been canceled. Otherwise, the subject matter of original claims 157-191 has been substantially retained, with some changes predominantly in form. New claim 192 retains elements corresponding to those in original claim 157, but the retained elements have been recast. Some of the deleted elements have been recast into the preamble. The wording changes are believed to be well-supported, to simplify the claims, and to improve their readability. The new claims are not narrower than those previously presented. The Appendix attached below maps each new claim to a corresponding original claim.

Applicant respectfully submits that Duncan is not a proper prior art reference under 35 U.S.C. 102(a), 102(b), or 102(e) with respect to new claim 192 and original claim 157. The subject patent application is a continuation-in-part of United States Patent No. 6,278,862 (hereinafter "Henderson '862"), which was filed on January 5, 1994, more than two months before the filing of Duncan. Henderson '862 discloses all of the elements of new claim 192 and original claim 157, and therefore these claims are entitled to priority back to January 5, 1994 so as to pre-date Duncan.

Specifically, with reference to Figure 3, Henderson '862 discloses providing a portable communication device (71) that is pageable by a paging network (61) to a called party; initiating communication between a calling party (11) and a telephone answering apparatus (15) through a telephone network¹; receiving caller identification information provided by the telephone network at the telephone answering apparatus²; transmitting the caller identification information from the telephone answering apparatus to the paging

¹ See Henderson '862, column 8, lines 27-33: "numeric paging network 61 is utilized to receive caller-identification information via interaction with telephone network 9 in response to call-originator 11 communicating through telephone network 9 with central office 59 of numeric paging network 61."

² See Henderson '862, column 8, lines 40-46: "the caller identification information is routed through telephone 17 to decoder 63 [which] comprises a conventional caller-identification decoder."

network³; transmitting the caller identification information from the paging network to the portable communication device⁴; and receiving the caller identification information transmitted from the paging network at the portable communication device⁵. Similar support can be found in Henderson '862 with reference to Figure 4, which shows operation in an alpha-numeric paging context. Thus, original claim 157 and new claim 192 are entitled to the filing date of Henderson '862 and therefore are patentable over Duncan.

New claims 193-222 (corresponding to original claims 159-163, 165-174, and 177-191) are directed to subject matter that either is disclosed in Henderson '862 (and is therefore entitled to the earlier priority date) or is not disclosed in Duncan (and is therefore not anticipated by Duncan). For example, it appears that the subject matter of at least claims 193-196, 198-200, 203, 210, 211, 217, and 219-222 is disclosed in Henderson '862, while it appears that the subject matter of the remaining claims is not disclosed in Duncan. Thus, Applicant respectfully submits that new claims 193-222 are allowable over Duncan, both alone and in combination with the other cited references.

Original claims 158, 164, 175, and 176 are directed to subject matter that may be disclosed in Duncan. Applicant does not concede that Duncan is a proper prior art reference under 35 U.S.C. 102 with respect to these claims. In order to facilitate prosecution, however, the subject matter of claims 158, 164, 175, and 176 has been canceled without prejudice. Applicant expressly reserves the right to pursue the canceled subject matter in one or more continuing applications.

Because Duncan has been eliminated as a prior art reference with respect to new claims 192-222, any differences between the new claims and the corresponding original claims should not be construed as amendments made to overcome prior art or for other reasons relating to patentability.

³ See Henderson '862, column 8, lines 56-60 "the decoded numeric information which corresponds to the telephone number of the telephone utilized by call-originator 11, and any numeric message input by call-originator 11, are assembled in message buffer 65, which pushes the serial bit stream to transmitter 67."

⁴ See Henderson '862, column 9, lines 4-7: "transmitter 67 provides a radio frequency communication link 69 which communicates information from numeric paging network central office 59 to personal communication device 71."

2. The Examiner objected to claims 157-191 under 35 U.S.C. 112, second paragraph as being indefinite with respect to reference of 'shift keyed data.'

Claim 192 (corresponding to original claim 157) includes "receiving ... caller identification information ... provided automatically by the telephone network" rather than "shift keyed data." Henderson '862 clearly discloses that the telephone network automatically provides caller identification information⁶ and therefore the new wording is believed to be well-supported. The new wording is consistent with both FSK-based caller identification signaling (e.g., original claim 162 and new claim 196) and ISDN-based caller identification signaling (e.g., original claim 163 and new claim 197).

3. The Examiner objected to claims 190-191 under 35 U.S.C. 112, second paragraph, as being indefinite with respect to the term "message center" and also with respect to the terms "contiguous memory locations" and "non-contiguous memory locations."

Claims 221 and 222 (corresponding to original claims 190 and 191) include "storing the caller identification information and the optional data ... by the telephone answering apparatus" rather than "storing the caller identification information and the optional data ... in a message center." The application clearly discloses that the caller identification data and optional data can be stored in either contiguous memory locations or non-contiguous memory locations (see page 16, lines 12-14, of the original specification).

4. The Examiner objected to the drawings.
Formal drawings are submitted herewith.

5. Applicant respectfully requests that the new docket number reflected above be used on all future correspondence.

⁵ See Henderson '862, column 9, lines 7-8: "personal communication device 61 may be a receive-only device, such as a paging device."

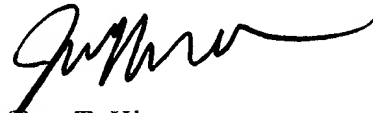
⁶ See Henderson '862, abstract: "caller-identification information is automatically transmitted through a telephone network;" see also Henderson '862, column 6, lines 20-23: "caller-identification information

6. All pending claims are believed to be in a form suitable for allowance. Therefore, the application is believed to be in a condition for allowance. The Applicant respectfully requests early allowance of the application. The Applicant requests that the Examiner contact the undersigned, Jeffrey T. Klayman, if it will assist further examination of this application.

7. This response includes a petition for a three month extension of time. Applicants request that deposit account number 19-4972 be charged for any fees that may be required for the timely consideration of this application.

Date: December 2, 2005

Respectfully submitted,



Jeffrey T. Klayman
Registration No. 39,250
Attorney for Applicants

Bromberg & Sunstein LLP
125 Summer Street
Boston, Massachusetts 02110-1618
Tel: (617) 443-9292
Fax: (617) 443-0004

3052/119 448409.1

APPENDIX

Original Claim	New Claim	Comments
157	192	
158	193	
159		Canceled
160	194	
161	195	
162	196	
163	197	
164		Canceled
165	198	
166	199	
167	200	
168	201	
169	202	
170	203	
171	204	
172	205	
173	206	
174	207	
175		Canceled
176		Canceled
177	208	
178	209	
179	210	
180	211	
181	212	
182	213	
183	214	
184	215	
185	216	
186	217	
187	218	
188	219	
189	220	
190	221	
191	222	